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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,588	04/09/2004	William K. Leonard	55476US041	1883
32692	7590	01/07/2005		
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER EDWARDS, LAURA ESTELLE	
			ART UNIT	PAPER NUMBER
			1734	
DATE MAILED: 01/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/821,588

Applicant(s)

LEONARD ET AL.

Examiner

Laura Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07/15 & 19/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Applicants' election with traverse of Group I, claims 1-4 in the reply filed on 10/25/04 is acknowledged. The traversal is on the ground(s) that all of the inventions relate to utilization of a desired number of pick and place devices in conjunction with wet coating which are searchable in Class 118 such that examination of all of the inventions would not place undue burden on the Examiner. This argument is not deemed persuasive because each Group defines a different aspect or invention as evidenced by Applicants' specification on page four, last paragraph. Each invention requires consideration in a different search area. Even though each Group includes a designated number of pick and place devices, each Group does not positively recite handling of the pick and place devices with respect to a wet coating. Examination of all of the different aspects or inventions claimed by Applicants would place an undue burden on the Examiner already substantially limited in examination time.

The requirement is deemed reasonable, proper, and is therefore made FINAL.

Specification

The disclosure is objected to because of the following informality: on page 1, lines 5-10, Applicants need to update the history of U.S. Application Serial 09/757,955 to reflect --U.S. Patent No. 6,737,113--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

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Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, Applicants recite options a or b followed by a statement in the last line that “the periods of at least three of the devices are not periodically related” and it is unclear how this phrase would be applicable to option b. when only two pick and place devices are used. Clarification is necessary.

In claim 2, it is unclear how this claim, in reciting a “wherein” clause, constitutes a structural limitation because no further structure is claimed or recited to effect the function of selecting the periods to provide for uniformity in coating.

In claims 3 and 4, Applicants recite a plurality of rolls but it is unclear whether these rolls are in addition to the pick and place devices recited in claim 1 or whether said plurality of rolls are the pick and place devices recited in claim 1. Clarification is necessary.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall (GB 1278099).

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Hall teaches an apparatus for improving uniformity of a liquid coating on a substrate comprising the combination of at least two or more pick-and-place devices (3; col. 1, lines 41-46) that rotate in the same direction, the pick and place devices being disposed on opposite sides of a coated substrate, each device reciprocating into and out of contact with the coated substrate so as to periodically contact and re-contact the coating at different positions on the substrate wherein the devices are out of phase with one another (see claim 5) constituting non-periodically related devices.

Conclusion

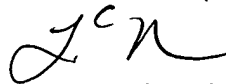
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents teach or suggest using pick and place devices to coat and recoat a substrate in the same place to fill a hole or aperture: Hembree (US 6,589,594).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Edwards whose telephone number is (571) 272-1227. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Laura Edwards
Primary Examiner
Art Unit 1734

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January 5, 2005